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EXAMINER

APPIAH, CHARLES NANA

ART UNIT

PAPER NUMBER

2682

21

DATE MAILED: 08/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/028,726

Applicant(s)

JOKIMIES, MATTI

Examiner

Charles Appiah

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 19.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments with respect to claim 1-10 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 4, 6 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by **Leih et al. (WO 95/07010)**.

Regarding claims 1, 4 and 6 Leih discloses a cellular radio system, a cellular radio terminal and a method to realize cell prioritizing in a cellular radio system which include terminals, cells and a network including stationary network equipment, of which the terminals are arranged to set up and maintain radio communication with base stations in the cells (feature of system for mobile communication that include mobile station, mobile communication domains corresponding to area covered by mobile communications network with each domain having fixed base stations and other network elements (see Figure 1, page 8, lines 5-13). According to Leih, at least one terminal is arranged to favor at least one cell based on data specific to that terminal stored in and received from the network with respect to other cells, (preference list being held in the (fixed) network of the system, e.g. in an exchange, see page 4, line

26 to page 5, line 5, with the determination of using a preference list to select a preferred communication domain or 'best' communication domain for establishing a connection, page 4, lines 9-17, see also page 6, lines 3-24).

Regarding claim 2, Leih's teaching of a preference list being held in the (fixed) network of the system such as an exchange with different users having their own preference lists (see page 4, lines 17-27), inherently reads on the stationary network equipment comprising a database for storing cell priority data relating to individual terminals. It is inherent that the provision of individual preference lists being stored in an exchange of the network would be in a database of the exchange.

Regarding claims 3 and 7 priority data stored in the database relating to the terminal, as a response to an excitation which is one of the following: the terminal registers with the cellular radio system, the terminal's location data changes in the cellular radio system, the priority data in the database is altered, a predetermined time has passed since the previous message to the terminal, which contained priority data relating to the terminal (see page 10, line 13 to page 11, line 20).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Leih et al** as applied to claims 4 and 6 above, and further in view of **Wang et al. (5,649,289)**.

Regarding claims 5 and 8 Leih further teaches that because an available communication domain is selected on the basis of a preference list, it is possible at all times to determine the “best” communication domain and to select it for establishing a connection (see page 4, lines 9 –17), and that it is possible to manage a separate preference list for each user and for each service, i.e. a separate preference list for each user-service pair (see page 4, lines 18-25), thus suggesting some form of an advantageous value for the domain of preference for a particular service. Leih fails to specifically disclose that the terminal is further arranged to maintain a list of possible cells for re-selection and to arrange the list in an order, which is based on a parameter, calculated for each cell, in which for priority cells, the terminal is arranged to alter the parameter calculation relating to the cell, so that the parameter has a particular advantageous value in the case of a priority cell.

However, it is very well known in the art to use certain defined parameters in maintaining cell re-selection data to favor priority cells as taught by Wang. Wang teaches the use of a user’s office or home location in assigning a cell of preference (see col. 4, lines 32-45). Wang further discloses using indexes in determining cells which are considered part of a preferred list for a customer paging area for a mobile subscriber (see col. 5, lines 35-67).

It would therefore have been obvious to one of ordinary skill in the art to combine

the teaching of Wang with the system of Leih for the benefit of ensuring the selection of priority cells for communication in order to reduce charges for mobile subscribers.

It would therefore have been obvious to one of ordinary skill in the art to incorporate the above teaching of Wang using a parameter to determine a priority list hierarchy into the system of Leih in order to identify the characteristics of preferable cells for cell selection for communication while maximizing the advantages for the subscriber such as reduced charges or special communication services.

6. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Leih et al** and **Wang et al** as applied to claim 8 above, and further in view of ETSI **(European Telecommunications Standards Institute), ETS 300 535 (GSM 03.22 version 4.10.0)**.

With respect to claims 9 and 10 Leih as modified by Wang, (as taught by Wang) further teach priority data relating to a terminal includes at least the priority cell identity (see FIG. 2). Leih as modified by Wang fail to specifically teach information as to whether or not the terminal shall apply an offset parameter, a delay factor relating to the cell and cell re-selection hysteresis in the calculation of the parameter relating to a priority cell in a situation where cell re-selection represents shifting from a non-priority cell to a priority cell.

However, it is known in the art to use cell re-selection hysteresis and the use of a delay factor in calculating parameters relating to cell re-selection as taught by GSM

03.22 version 4.10.0. The specification teaches that for cell re-selection in cell prioritization, a hysteresis factor as well as an offset value can be used in determining a parameter (C2) (see sections 3.4- 3.5.2.2)

It would therefore have been obvious to one of ordinary skill in the art to use a delay factor in the system of Leih and Wang as taught by the ETSI standard for cell re-selection hysteresis in making decisions regarding movement to and from priority cells as desired for the benefit of encouraging or discouraging re-selection of specific prioritized cells.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Buhrmann et al. (5,950,125) discloses a location-dependent cellular service profile system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Appiah whose telephone number is 703 305-4772. The examiner can normally be reached on M-F 7:30AM-5:00PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on 703 305-6739. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9314 for regular communications and 703 308-6296 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service receptionist whose telephone number is 703 306-0377.

Charles Appiah  
August 5, 2002

  
**CHARLES APPIAH**  
**PATENT EXAMINER**